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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,710	02/20/2004	Koji Sakuta	TAKIT-144-D2	4197

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EXAMINER

LEWIS, AMY A

ART UNIT PAPER NUMBER

1614

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/781,710

Applicant(s)

SAKUTA, KOJI

Examiner

Amy A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/180,072.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of the Case*

The Preliminary Amendments and Remarks, filed 3 June 2004, have been entered into the application. Accordingly, the specification has been amended to include continuity data, claims 1-7 have been cancelled without prejudice or disclaimer, and claims 8-15 have been added. Claims 8-15, as they appear on pages 2-4 of the document filed 20 February 2004, are currently pending.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of 177904/99 (Japan), filed on 27 June 1999 has been filed in parent Application No. 10/180072.

### *Double Patenting*

The nonstatutory obviousness-type double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-11, 13, 15, and 18-20 of copending Application No. 10/180072. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are directed to a non-aqueous dermatic cosmetic material for perspiration control comprising a cross-linked silicon polymer with hydrophilic polyoxyalkylene moieties and wherein the silicon polymer is produced by an addition polymerization reaction.

It would have been obvious to modify the composition of the 10/180072 patent to make the material of the instant application through routine optimization of the amounts of ingredients. Although instant application teaches 50 to 500 parts by weight of an aluminum compound (claim 8 & 12) and 10/180072 teaches 50 to 300 parts by weight of an aluminum compound (see claim 15), absent evidence to the contrary, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have optimized the concentration (parts by weight) for the aluminum compound. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Once Application No. 10/180072 has issued, this rejection will no longer be provisional.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. 6,060,546 and further in view of Tachibana et al., 5,412,004.

Powell et al. teach non-aqueous silicone emulsions containing a silicone phase and an organic phase for use in various personal care compositions. Powell teaches the preparation of cross-linked silicone polymers in volatile, low molecular weight silicone oil. The reference teaches antiperspirants as a preferred embodiment of personal care products and that aluminum chlorohydrate and aluminum-zirconium chlorohydrate (of instant claim 11) as antiperspirant active ingredients in antiperspirant compositions. See: col. 3, line 22 - col. 4, line 67; col. 15, line 40 - col. 17, line 67; col. 31, line 64 - col. 32, line 67; and abstract.

Although the primary reference teaches cross-linked silicone polymers, silicone oils, lower alcohols, and vitamin C as being useful in non-aqueous silicone emulsified personal care

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compositions, it lacks the specific cross-linked silicone polymer with the polyoxyethylene moieties of instant claim 8.

Tachibana et al., teach a silicone polymer that can swell in silicone oils and function as a viscosity-increasing agent for silicone oils. The secondary reference teaches that if the silicone polymer is kneaded under a shearing force a paste-like composition is formed which can disperse powders and pigments in a stable manner without precipitating them and is therefore useful as a base material for creams, cakes. See: col. 7, lines 32-45. The reference teaches the use of polyoxyalkylenes, olyoxyethylenes, organopolysilicones, organohydrogenpolysiloxanes and the use of these reactants in addition polymerization reactions (of instant claims 9, 10, and 14). See: col. 2 lines 20-45 and col. 7, lines 8-45). The reference also describes the use of silicone oils and alcohols as claimed instantly in claim 8 and 13 of the instant application. See: col. 7 lines 8-60.

Further, the reference teaches that "optional components include conventionally used aqueous components and oil components e.g., moisturizers, preservatives, anti-oxidants, UV absorbers, skin-improvers, perfumes, water soluble polymer, tar components, and the like... and there are no specific limitations as to the cosmetic powders to be used." See: col. 10, line 61 - col. 11, line 5. The reference also describes "the addition of one or more components selected from the group consisting of sugars, sugar alcohols, and inorganic salts as water phase components remarkably improves the stability of the composition..." See: col. 9 lines 18-45.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified non-aqueous personal care products, and method of making the non-aqueous personal care products, of Powell et al., by sing the silicone polymer of Tachibana et al., because of the reasonable expectation of obtaining a non-aqueous antiperspirant

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composition comprising a silicone polymer which is capable of dispersing cosmetic powders and pigments in a stable manner without precipitating them while simultaneously increasing the viscosity of the silicone oils.

***Conclusion***

Claims 1-15 are rejected. No claims are allowed.

**Contact Information:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy A. Lewis whose telephone number is (571) 272-2765. The examiner can normally be reached on Monday-Friday, 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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